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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------|------------------|
| 09/655,596   | 09/06/2000  | William F. Beausoleil | POU9-2000-0048-US1  | 9320             |
| 34313  | 7590        | 08/04/2004            | EXAMINER            |                  |
| ORRICK, HERRINGTON & SUTCLIFFE, LLP<br>4 PARK PLAZA<br>SUITE 1600<br>IRVINE, CA 92614-2558 |             |                       | VU, TUAN A          |                  |
|  |             |                       | ART UNIT            | PAPER NUMBER     |
|  |             |                       | 2124                |                  |

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

### DETAILED ACTION

1. This action is responsive to the Applicant's response filed 5/04/2004.

As indicated in Applicant's response, claims 1-4 are pending in the office action.

#### *Response to Amendment*

2. The amendment to the set of claims filed on 5/04/2004 (which Applicants remark as replacing all prior versions thereof) does not comply with the requirements of 37 CFR 1.121(c) because of the following reasons.

As per claim 1, this claim is dependent on claim 1, which is not appropriate for a dependent claim to depend onto itself.

As per claim 2, this claim also depends on claim 2, i.e. on itself.

As per claim 4, this claim depends on an invalid claim 1.

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (*e.g.*, Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required*. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of

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“currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

Since the reply filed on 5/04/2004 appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

As it stands, even the claims referred to in the arguments provided in the current Applicants' Remarks do not map the current claims numbering. In fact, for example, the current claim 3 would be claim 1 as perceived from those remarks. Examiner would like to give Applicants the benefit of being able to rectify the errors so that a full set of claims would be

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resubmitted. A full response then will be put forth taking into consideration the whole corrected claimed invention. This would obviate the scenario in which only claim 3 as of now is rejected and addressed, thus leaving out the rest of Applicants' invention, and possibly negating the opportunity for applicants to respond in the eventuality of a potential finality of that rejection.

***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (703)305-7207. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 ( for formal communications intended for entry)

**or:** (703) 746-8734 ( for informal or draft communications, please consult Examiner before using this number)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA. , 22202. 4<sup>th</sup> Floor( Receptionist).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT

July 15, 2004



**ANIL KHATRI**  
**PRIMARY EXAMINER**

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